

REMARKS/ARGUMENTS

Restriction is required between:

- I. Claims 1-14, drawn to an aromatization process, classified in class 585, subclass 418
- II. Claims 15-21, drawn to a method of making a catalyst classified in class 502, subclass 66
- III. Claims 22-36, drawn to a catalyst, classified in class 502, subclass 66

The applicants confirm the election of Group I, Claims 1-14, with traverse.

The Examiner has required restriction under 35 USC §121. It is stated in 35 USC §121 that restriction may be required when "two or more independent and distinct inventions are claimed in one application" (emphasis added). Even assuming that the groups of claims of the present invention are distinct, the Examiner has not shown how they are independent. For this reason alone, i.e., failure to meet a statutory prerequisite, the restriction requirement should be withdrawn.

The examiner argues that Group I and Group II are related as product and process of use and that the product can be used in a materially different process of use [MPEP §806.05(h)]. The applicants respectfully point out that Group I is drawn to an aromatization process and Group II is drawn to a method of making a catalyst. Neither group of claims is directed to a product.

The examiner argues that Group II and Group III are related as process of making and product made and the product can be made by another materially different process [MPEP §806.05(f)].

The examiner's restriction requirement is based on the finding that the groups of claims are patentably distinct. MPEP §802 defines distinct as follows:

“DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). . . .”

Applicant submits that the Examiner has not shown the claims of Group I, Group II and Group III to be distinct in accordance with the above definition. The catalyst of Group III is the very catalyst used in the process of Group I and made in the method of Group II.

As set forth in MPEP §806.04, a restriction requirement is appropriate for two different combinations not disclosed as capable of use together, for process and apparatus and independent species under a genus. As set forth in MPEP §808.01, restriction requirement is appropriate when inventions are not connected in design, operation or effect and are unrelated which, as noted by the MPEP, is a rare situation. The examiner admits that Group II and Group III are related and that Group I and Group III are related. It would appear that Group I and Group II are related by the examiner's own admission through Group III.

As noted by MPEP § 803:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

“There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).”

Applicant submits that for the reasons below examination of the claims of Group I, Group II and Group III does not present a serious burden on the Examiner.

Assuming that the restriction requirement is between Group I and Group III and that the two groups are patentably distinct, the applicants respectfully point out that the asserted utility of the catalysts set forth in the claims of Group I is as a catalyst of a particular composition and the asserted utility of the process set forth in the claims of Group I is in the process for aromatization of hydrocarbons using the catalysts of Group III. This being the case, it would appear that the field of search for the subject matter of Group I would include the field of search for the subject matter of Group III. Since the fields of search for the two groups of claims would appear to be largely co-extensive, examination of the two inventions, even assuming that they are directed to patentably distinct inventions, would best serve the interest of the Patent and Trademark Office, the public and the present applicants. Accordingly, the applicants respectfully request that the restriction requirement between Group I and Group III be withdrawn.

Assuming that the claims of Group II and Group III are directed to patentably distinct subject matter, the applicants respectfully point out that the asserted utility of the catalysts set forth in the claims of Group III is as a catalyst of a particular composition and the asserted utility of the process set forth in the claims of Group II is in the method of making the catalysts of Group III. This being the case, it would appear that the field of search for the subject matter of

Group II would include the field of search for the subject matter of Group III. In fact, the applicants note that the both Group II and Group III are classified in class 502, subclass 66. Since the fields of search for the two groups of claims would appear to be largely co-extensive, examination of the two inventions, even assuming that they are directed to patentably distinct inventions, would best serve the interest of the Patent and Trademark Office, the public and the present applicants. Moreover, it is noted that the PTO has issued patents in this field of technology containing claims directed to both catalysts and methods of making catalysts. Accordingly, the applicants respectfully request that the restriction requirement between Group II and Group III be withdrawn.

Accordingly, because the claims of Group I, Group II and Group III are not independent or distinct inventions under MPEP standards and no serious burden is presented by an examination of the groups of claims together, the applicant respectfully requests that the restriction requirement be withdrawn.

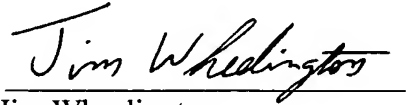
The Applicants believe that no extension of term is required. However, this conditional petition is being made to provide for the possibility that the Applicants have inadvertently overlooked the need for a petition and fee for extension of time. If an additional extension of time is required, please consider this a petition therefor. The Commissioner is hereby authorized to charge any additional fees due by filing this paper or to credit any overpayment to Account No. 502025.

SERIAL NO. 10/792,319
JUTTU, SMITH

PATENT APPLICATION
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On the basis of the above remarks, reconsideration of this application is requested and withdrawal of the restriction requirement is requested at the examiner's earliest convenience.

Respectfully submitted,



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